REMARKS/ARGUMENTS

In the last Office Action herein dated July 29, 2003, the Examiner objected to certain document references found on pages 3 and 4 in the specification, suggesting that these references be deleted from the text. Inasmuch as applicants have, earlier in the prosecution of this case, introduced those referenced documents into the file history of this case by way of an information disclosure statement, applicants, in this amendment, propose related changes in the specification which deal with this issue.

Additionally, the Examiner rejected the single claim in this application under 35 U.S.C. § 102 (e) on the basis of U.S. Patent No. 6,195,917 B1 to Dieckhaus, and additionally under 35 U.S. C. § 103 (a) on the basis of a proposed combination of Dieckhaus with two identified technical reference documents.

In the Specification, pages 3 and 4 have been amended.

In the Claims, no changes

Applicants have carefully reviewed the specification, claims, abstract and drawings in this case, along with the single cited U.S. Patent reference and the two cited technical documents, as well as the Examiner's comments, and respectfully urge that claim 4, as it is currently presented in this case, is very clearly distinguishable from both novelty and obviousness points of view from the cited and applied art. Applicants' reasoning is now stated below.

There is a very key element which is missing from the cited and applied art, the absence of which plainly sets the stage for applicants' claim 4 to be deemed patentable and allowable. This is not a modest difference between the cited and applied art and the claimed

invention. It relates to the issue of springiness. Applicants know of no instance in the prior art of a proposal that a cushioning shoe insole should be anything other than springy. Put another way, the default reasoning ubiquitously applied to the creation of cushioning insoles is that it is very important that they offer a springy response to a foot-produced deflection/deformation. Prior to introduction of the teachings in this case regarding applicants' invention, the skill and level in the art does not recognize that springiness in an insole is a *contributor* to potential injury rather than a guard against such an injury. A springy response functions to deliver a rebound behavior in relation to an initial impact deflection, and this rebound behavior has the effect of multiplying the opportunity for a particular footfall event to generate an injury. In other words, springiness in a shoe insole is a contributor to the problem of injury. It is not a solver of that problem.

Applicants' claimed invention clearly calls for a *non-springy*, viscoelastic, acceleration-rate-sensitive cushioning material, and applicants have disclosed in their patent application, in support of their claim, a non-springy, viscoelastic, acceleration-rate-sensitive material which happens to be one of the many materials which are made and sold under the PORON® trademark. Notwithstanding the fact that, under the PORON® trademark, a material which fits the requirements of applicants' invention is made available, there is absolutely nothing in the art short of applicants' own teaching respecting their shoe insole which would lead one to move the construction of a shoe insole toward and into a "non-springy" "camp".

Accordingly, the non-springiness limitation which is present in applicants' claim is an important structural feature of the invention, and it is simply not present in the cited and applied art in any sense which supports a prior art rejection of applicants' claim.

As one can clearly see from a reading of the text beginning at column 5, in a paragraph which starts at line 14, the Dieckhaus teaching relates to an insole which is formed of a cushioning urethane "which is shock-absorbing, and has *rebound* (emphasis added) to it, to add to the resiliency and comfort of the shoe."

Dieckhaus thus leads one in the conventional way of thinking about insole design by selecting and teaching, and thus urging the use of, a springy rebound material which, as is apparent, is one type of material which is sold under the PORON® trademark. Applicants' identified and claimed cushioning material is very different, in that it has no springiness, rebound characteristic.

Applicants thus urge that Dieckhaus cannot be said to read directly upon claim 4.

The rejection of claim 4 on the ground of obviousness also runs into the same very important and clearly distinguishing difficulty. The Examiner's own language in proposing a combination sets this difficulty clearly into view. The Examiner states "it would have been obvious to provide the PORON® foamed layer (4) of Dieckhaus *with* (emphasis added) the PORON® foamed material, as taught by Rogers, to provide improved cushioning characteristics." The Examiner's thus-proposed lamination of two different kinds of PORON®, one of which might be the same as applicants' claimed material, and the other of which would definitively be the PORON® material taught by Dieckhaus, would produce a PORON® combinational layer arrangement which would definitively have a springy rebound characteristic, because of the presence in it of the very material which Dieckhaus teaches to be a springy rebound material.

Thus, quite apart from the fact that applicants do not find any suggestion that is

tenable which suggests that a Dieckhaus insole could be modified by removing rebound characteristics, and no suggestion that the Dieckhaus rebound phenomena should be moderated by combining with the Dieckhaus-taught material another formed of PORON® which does not have rebound, the combination proposed by the Examiner would definitely not produce applicants' claimed invention.

Accordingly, and for all of the reasons given above, applicants respectfully request a favorable reconsideration, and an early formal allowance, of claim 4. If the Examiner has any questions regarding the amendment or remarks, the Examiner is invited to contact Attorney-of-Record Jon M. Dickinson, Esq., at 503-504-2271.

Customer Number

23855

Respectfully Submitted,

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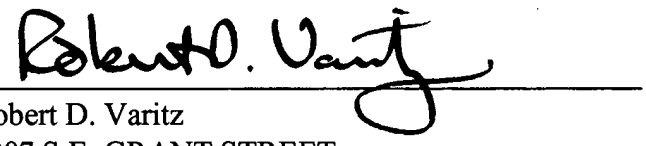

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